

REMARKS

The Pending Claims:

Claims 1-16 are pending and under active consideration.

The Amendment:

Claims 1, 3, 6-8 and 13 are currently amended. The amendments do not narrow the scope of the previously presented claims, but merely involve formalities, grammatical oversights/preferences, typological errors, and the like. These amendments to the claims are made solely to obtain expeditious allowance of the instant application and not for reasons related to patentability. Amendment of the claims is made without prejudice, without intent to abandon any originally claimed subject matter, and without intent to acquiesce in any rejection of record.

Entry of the claim amendments is respectfully requested.

CLAIM REJECTION—35 U.S.C. § 112

Claims 1-16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the claims are rejected for purportedly containing new matter not described in the application as filed.

Although Applicants respectfully disagree with this rejection, in order to expedite allowance of the present application, the previously introduced “forming a hydrophobic passivating layer” step has been removed. In view of the amendment, withdrawal of the rejection under 35 U.S.C. § 112, first paragraph is respectfully requested.

CLAIM REJECTION—35 U.S.C. § 103

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bawendi (U.S. Patent No. 6,319,426) in view of Kohn et al. (WO 99/24490) and over Bawendi in view of Ma et al. (U.S. Patent No. 5,221,334).

Applicants respectfully request that all obviousness rejection based upon Bawendi et al. (U.S. Patent No. 6,319,426) be withdrawn pursuant to 35 U.S.C. § 103(c).

Section 103(c)(1) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Accordingly, section 103(c) requires (1) that the subject matter of the present invention and the cited patent application have different inventive entities; (2) that the cited patent application be available as prior art under section 102(e), (f) or (g); and (3) that the present invention and the cited patent application were owned by the same person, or subject to an obligation of assignment to the same person, at the time the present invention was made.

Section 103(c)(2) states:

(2) For the purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

Accordingly, inventions developed under a joint research agreement, which is defined as “a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, development or research

work in the field of the claimed invention," are deemed to have been owned by the same person for the purposes of 103(c).

In view of the following, Applicants respectfully submit that the subject matter of U.S. Patent No. 6,319,426 satisfies the requirements for disqualification under 35 U.S.C. § 103(c).

(1) The subject matter of the present invention was developed by a different inventive entity form that of U.S. Patent No. 6,319,426.

(2) U.S. Patent No. 6,319,426 is available only as 102(e)-type prior art. The present application was filed on November 18, 2003 and is a divisional application of U.S. Patent Application No. 09/841,237, which was filed April 23, 2001 and properly claims priority to U.S. Provisional Patent Application No. 60/240,216, which was filed October 13, 2000. The cited reference, U.S. Patent No. 6,319,426, was published on November 20, 2001, well after the priority date the present application is entitled to. Hence, U.S. Patent No. 6,319,426 is not available as prior art under § 102(a) or § 102(b).

(3) The claimed invention was made by or on behalf of parties to a joint research agreement, as defined under 35 U.S.C. § 103(c)(3), that was in effect on or before the date the claimed invention was made.

According to M.P.E.P. § 706.02 (II and III), to overcome a rejection under 35 U.S.C. § 103(a) via the CREATE Act, the applicant must provide a statement to the effect that the disqualified subject matter and the claimed invention were made by or on the behalf of parties to a joint research agreement within the meaning of 35 U.S.C. § 103(c)(3), that the joint research agreement was in effect on or before the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. The statement should be or begin on a separate sheet and must not be directed to other matters (37 CFR 1.4(c)). Evidence to support the statement is not required. Accordingly, Applicant has included the necessary statement herewith.

In view of the foregoing, Applicants respectfully request that the rejections based upon U.S. Patent No. 6,319,426 to Bawendi be withdrawn. Absent rejections based upon U.S. Patent No. 6,319,426, no rejections remain. Therefore, early allowance of all pending claims is respectfully requested.

The Examiner is requested to contact the undersigned agent if an interview, telephonic or personal, would facilitate allowance of the claims.

Respectfully submitted,

Date: November 30, 2006

/Joel Silver/
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STATEMENT OF JOINT RESEARCH AGREEMENT AS PROVIDED UNDER
35 U.S.C. § 103(c)

The subject matter of U.S. Application No. 10/717,246 and U.S. Patent No. 6,319,426 was, at the time the invention of U.S. Application No. 10/717,246 was made, subject to a joint research agreement within the meaning of 35 U.S.C. § 103(c)(3), and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

Executed this 30th day of November, 2006, in Eugene, Oregon.

/Joel Silver/
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